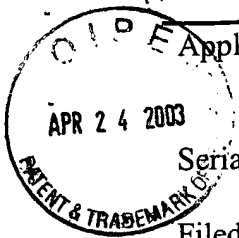


2151/18

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant(s):

Curry, et. al.

Serial No.: 09/683,706

Filed: 2/5/2002

Title: Integration of audio or video program
with application program

Attorney Docket No.: 1049.001US1

Group Art Unit:
2151

#4

Examiner:

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. 1.102

RECEIVED

Assistant Commissioner for Patents
Washington, D.C. 20231

APR 25 2003

Technology Center 2100

Dear Sir:

This is a Petition to Make Special the above-identified patent application. The basis for this petition is actual infringement.

In accordance with this Petition, seven (7) pages of support information are attached hereto, as signed for by Applicant's Attorney.

Payment of the Petition fee of \$130 is made by credit card via the attached Form PTO-2038.

In view of the above, Applicant requests that the Petition to Make Special be granted and the examination of the application be advanced.

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Respectfully Submitted,

Michael A. Dryja
Registered Patent Attorney

Michael A. Dryja
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Tel. 425-427-5094

I hereby certify that this is being deposited with the
United States Postal Service as first class mail in
an envelope addressed to The Assistant
Commissioner for Patents, Washington, DC
20231 on.

4-19-03

date, by

MICHAEL DRYJA

printed name

signature

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Curry et al.

Application No.: 09/683,706 (CONF 6456)

Filed: 2/5/2002

Title: Integration of audio or video program with
application program

Attorney Docket No.: 1049.001US1

Group Art Unit:
2151

Examiner:

Assistant Commissioner for Patents
Washington, D.C. 20231

RECEIVED

APR 25 2003

SUPPORTING INFORMATION TO PETITION TO MAKE SPECIAL Technology Center 2100

Dear Sir:

The following remarks are presented as supporting information to the petition to make special filed herewith, in accordance with 37 CFR 1.102. The basis for the petition to make special is in accordance with MPEP section 708.02, II, that the application be made special because of actual infringement. These remarks are organized in accordance with the lettered headings (A)-(C) of MPEP section 708.02, II, and the lettered headings (A)-(E) of MPEP section 708.02, VIII.

708.02, II.(A)

Applicant's attorney alleges, based upon information and belief, that there is an infringing device or product actually on the market, or method in use, of at least some of the claims of the patent application in question. This infringing product is identified as ConnectMail Video Messaging, available from ConnectMail, Ltd., of Cincinnati, Ohio. Information regarding ConnectMail Video Messaging is available at the Internet web site www.ConnectMail.com. Selected web pages from this web site have been printed off by Applicant's attorney, and are attached hereto as Exhibit 1.

708.02, II.(B)

Applicant's attorney alleges, based upon information and belief, that a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that in his opinion, some of the claims are unquestionably infringed. The following claim chart of claim 1 is provided as an example of this allegation.

Claim limitation or element following the preamble "A system comprising:"	Corresponding infringement by ConnectMail Video Messaging, as taken from the web pages of Exhibit 1
"an operating system;"	ConnectMail Video Messaging is compatible with Microsoft Outlook 98/2000 and Lotus Notes version R5, both of which are programs that are commonly known run on the Microsoft Windows operating system, such that ConnectMail Video Messaging inherently is inclusive of this claim element or limitation.
"an application program running on the operating system; and,"	ConnectMail Video Messaging is compatible with Microsoft Outlook 98/2000 and Lotus Notes version R5, both of which are known application programs, providing email and other functionality.
"an audio or video program running on the operating system,"	ConnectMail Video Messaging is the audio or video program, adding "full-motion video and audio capabilities"; because it is compatible with Microsoft Outlook 98/2000 and Lotus Notes version R5, ConnectMail Video Messaging inherently runs on the Microsoft Windows operating system as well, as known within the art.
"the audio or video program integrated with the application program, such that a user of the application program interacts with the audio or video program as though the audio or video program were part of the application program."	ConnectMail Video Messaging is "completely integrated" and "is integrated into many of the email and other messaging services and software packages that you use on a regular basis." "ConnectMail takes the tool you prefer – email – and adds full-motion video and audio capabilities without taking anything away. You don't have to change the email client you like [I]t works . . . with the email systems widely in use today like webmail, Microsoft Outlook, and Lotus Notes." "Access to all current functionality of email client including: address book, reply/forward" and "Ability to send combined text and media messages"

708.02, II.(C)

Applicant's attorney alleges, based upon information and belief, that a careful and thorough search of the prior art has been made, and/or that Applicant has a good knowledge of the pertinent prior art. Details regarding the prior art search and the prior art are provided below, in conjunction with 708.02, VIII.(C), (D), and (E).

708.02, VIII.(A)

Applicant's attorney has submitted herewith a petition to make special, accompanied by the fee set forth in 37 CFR 1.17(h).

708.02, VIII.(B)

Applicant's attorney presents all the claims, 1-20, in the pending patent application in question, as filed, as being directed to a single invention. These claims are not duplicated here. Applicant's attorney therefore asserts that no election of claims is necessary. However, in the alternative, Applicant's attorney provides the Patent & Trademark Office as suggestive guidance that claims 1-11 be elected should the Office determine such election be necessary.

708.02, VIII.(C)

Applicant's attorney submits that a careful and thorough pre-examination search has been made. Applicant's attorney conducted a keyword prior art search of both domestic and foreign issued patents and published patent applications, utilizing the subscription patent document search engine service Delphion, available at the Internet web site, www.Delphion.com. Specifically, prior art was searched for that related to the integration of audio or video recording or playback within software applications. Within the prior art that was then found, prior art was searched for in which the integration is accomplished via a separate program that is integrated with a main application program, although no such latter prior art was specifically found.

In addition, Applicant's attorney received from Applicant the results of a previous prior art search conducted by Applicant's previous counsel before retaining current counsel. An outside search agent conducted this prior art search. Finally, Applicant has a good knowledge of the pertinent prior art, and provided Applicant's attorney with additional prior art references that were not found in Applicant's attorney's own search or in Applicant's previous counsel's search. All of the prior art references that have been discovered have previously been submitted via the Information Disclosure Statement (IDS) deposited by First Class Mail on March 16, 2002, via the supplemental IDS filed electronically on August 15, 2002, and via the supplemental IDS deposited by First Class Mail on August 16, 2002.

708.02, VIII.(D)

By information and belief, Applicant's attorney alleges that the most closely related prior art references are: Budge et al., US Pat. No. 6,014,689; Venkatraman et al., US Pat. No. 6,014,688; and international patent application America Online, Inc., WO 02/09,437 A2. It is noted that all three of these references are already on record. The Budge and Venkatraman references were submitted in the IDS deposited on March 16, 2002, whereas the America Online reference was submitted in the supplemental IDS deposited on August 16, 2002.

708.02, VIII.(E)

Applicant's attorney now provides a detailed discussion of the references identified above, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references. Applicant notes that there are three independent claims pending, claims 1, 12, and 19. Each of the independent claims is limited to an audio or video program that is integrated with an application program. Claim 1 is limited to "a user of the application program interact[ing] with the audio or video program as though the audio or video program were part of the application program." Claims 12 and 19 are limited to "an audio or video program encompassing . . . one or more audio or video controls . . .

integrated with the predetermined application program.” The remaining claims ultimately depend off one of the independent claims 1, 12, or 19, and are therefore patentable for at least the same reasons that claims 1, 12, and 19 are.

None of the references, either alone or in combination, anticipate or render obvious the claimed subject matter. That is, none of the references, either alone or in combination, anticipate or render obvious a separate audio or video program that is integrated with a separate application program, such that the user of the application program interacts with the audio or video program as if the latter program were part of the former program, or such that the audio or video program has controls that are integrated within the application program. Specifically, neither the Budge reference, Venkatraman reference, nor the America Online reference, either alone or in combination anticipate or render obvious the claimed subject matter.

Specifically with respect to Budge, a video e-mail recorder 210 is disclosed (FIG. 3, col. 4, ll. 42 et seq.) with which video e-mail is recorded. The recorder 210 is analogous to the audio or video program of the claimed invention. However, the recorder 210 is not integrated within an application program. “The video e-mail recorder 210 . . . executes the Email client 270 and passes the video e-mail file to the Email client 270.” (Col. 4, ll. 33-35) The Email client 270 is analogous to the application program of the claimed invention. Thus, the recorder 210 only executes the client 270, or only passes a video email file to the client 270. The recorder 210 is not integrated within the client 270 such that the user interacts with the former program as if it were part of the latter program, nor are the controls of the former program integrated within the latter program, to which the claimed invention is limited. Budge, either alone or in combination with any of the other references, does not anticipate nor render obvious the claimed invention.

Further evidence with respect to the inapplicability of Budge to the claimed invention is how received video e-mail is handled. A player program is attached to the video e-mail to create an executable file. (Abstract) Once the video e-mail is received, “the recipient executes the received file and the attached player automatically plays the video and audio message or the recipient executes the previously installed player which plays the video message.” (Abstract)

Thus, the player program, which is also analogous to the audio or video program of the claimed invention, is separate from the email client program. The recipient executes the player program separately from the email client program, either by executing the receiving player program, or by executing the player program as has been previously installed. The user does not interact with the player program as if it were part of the email client program, nor are the controls of the player program integrated within the email client program. Budge, either alone or in combination with any of the other references, does not anticipate nor render obvious the claimed invention.

With respect to Venkatraman, creation software is used to generate an email that includes audio or video, and that also includes executable embedded software for viewing the audio or video. (Abstract) Such creation software, and such embedded software, are analogous to the audio or video program of the claimed invention. To send and receive the email, Venkatraman relies upon an "e-mail platform." (Col. 1, ll. 52-55) The e-mail platform is analogous to the application program of the claimed invention. However, the creation software and the embedded software are not integrated within the e-mail platform. For instance, once an audio or video email is received, "the executable software that is transmitted as part of the E-mail message . . . contains a self-opening message feature, such that the container automatically opens and is initially viewed with all of the desired [audio or video] content appearing." (Col. 2, ll. 6-11) "Such content . . . will be viewable, regardless of the E-mail platform of the recipient, due to the inclusion of the executable software in the E-mail message itself that is transmitted." (Col. 2, ll. 14-19) This executable software that is embedded within the e-mail message thus opens up independent of the e-mail platform, such that the user does not interact with the software as if it were part of the e-mail platform, nor are the controls of the software integrated within the e-mail platform. Venkatraman, either alone or in combination with any of the other references, does not anticipate nor render obvious the claimed invention.

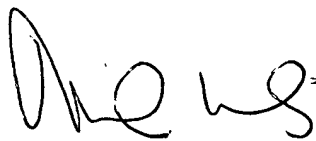
Finally, with respect to America Online, an "instant messaging host" is described within which "video communication is enabled." (P. 1, ll. 28-32) The host is capable of displaying on a user's screen both a "standard instant message [user interface]" and "a video-enabled [user

interface]”. (P. 19, ll. 29-31) However, both of these user interfaces are part of the same program, the host. That is, unlike the claimed invention, there are not separate application programs and separate audio or video programs. Rather, a single program includes both standard instant message capability and video-enabled instant message capability. Thus, in America Online, there is either an “application program” or an “audio or video program,” and not both programs, such that America Online is missing one of the elements of the claimed invention. America Online, either alone or in combination, therefore does not anticipate nor render obvious the claimed invention.

Respectfully Submitted,

4-18-03

Date



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ConnectMail Video Messaging

ConnectMail: The Future of Email....Today

"By 2005, video email will replace text messages as the main online communication mechanism. Text-based email will seem as archaic as black-and-white TV."

- Jeremy Schwartz
Senior Analyst Media & Entertainment
Forrester Research

Today, email is the communication tool of choice, surpassing the telephone. Yet, anyone that uses email knows that there are limitations to communicating with text-based messaging systems – it was not the way humans were meant to communicate effectively. With text, what you mean is not always the message that is received. For example:

- Non-verbal communication (body language) comprises over 80% of communication, and is impossible to express using text
- Tone, emotion, and sarcasm are often miscommunicated in text
- Many people simply do not feel comfortable expressing themselves "through their fingers" on a keyboard

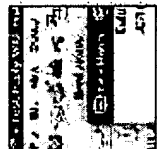
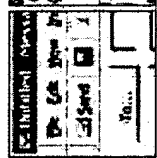
Say More, Type Less with ConnectMail

ConnectMail takes the tool you prefer – email – and adds full-motion video and audio capabilities without taking anything away. You don't have to change the email client

Products

ConnectMail's offering consists of three unique products:

- ConnectMail for Microsoft Outlook
- ConnectMail for Lotus Notes
- ConnectMail for Openwave MX
- ConnectMail SDK (Software Development Kit) for customized implementations of other web-based email and messaging systems (available to authorized resellers only)



OutlookNotes
CLICK TO SEE FULL-SIZE

EXHIBIT 1

you like, the email provider you like or even the bandwidth connection you have. Yes, it works on the computers widely in use today -- with the email systems widely in use today like webmail, Microsoft Outlook? and Lotus Notes? . No waiting for the telephone provider to provide the latest high speed connections. No expensive new hardware to purchase (it works with even low end webcams).

Nothing changes.....except your ability to express yourself more easily than before.

So you can go back to more personalized and natural communications with family, friends, employees, customers, suppliers and prospects -- through email. Click in the box to the right to view sample uses of ConnectMail and judge the difference for yourself.

Sample Uses

Want To See Some?

ConnectMail Video Messages can really change the impact of your email. Click [HERE](#) to experience what it's like to receive a ConnectMail Video email.

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- Main
- Features



Client Software

- ✗ Compatible with Outlook 98/2000 and with Notes version R5
- ✗ Completely integrated, easy to install Outlook form
- ✗ Ability to record messages in video or audio only format
- ✗ Compatible with variety of web camera hardware
- ✗ Easy to use interface, including VCR-like buttons
- ✗ Ability to send messages internal and external to organization
- ✗ Ability to send combined text and media messages
- ✗ Access to all current functionality of email client including: address book, reply//forward
- ✗ Ability to save media messages to local drives
- ✗ Complete end user documentation

Server Software

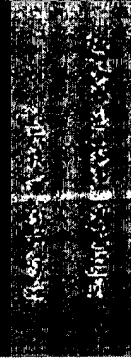
- ✗ Comes complete with variety of supporting software including: Windows Media Services, Apache 3.12, Mod Perl, SendMail, Samba,
- ✗ FTP software, MySQL and Access Components, WebMin, PHP Admin, and more...
- ✗ Quality playback over 28.8 connections
- ✗ Complete control over video quality with admin tools
- ✗ Web-based end user help
- ✗ Installation Guide including Planning Guide
- ✗ Admin. Guide
- ✗ Configuration tools

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ConnectMail vs. Email

Think of ConnectMail as your email on steroids. ConnectMail video messaging lets you do and say a whole lot more than you can with just your basic, everyday email software. In the coming months, you'll find ConnectMail integrated into many of the email and other messaging services and software packages that you use on a regular basis. In the meantime, read more about what ConnectMail can do for you below, or sign up to try ConnectMail right now, for FREE, and experience how it can make your communication more personal, dynamic and fun.

What's in it for Me?

ConnectMail gives you more choices to communicate in the right way at the right time.

- Send messages that include full-motion video and audio (just as if you recorded yourself on videotape to be played in a VCR), audio only, and text messages (like conventional email). You can even add file attachments, such as digital photos, word processing documents or sound files.
- Connect with your family while away on a business trip, record messages that allow grandchildren miles away to see and hear you, or check in with mom and dad while you're away at school.

ConnectMail makes communicating easier and more natural.

- ✧ Just point, click, record and send. Review your message before sending if you want to see what it looks and sounds like. Record as many times as you like. You're in control.
- ✧ Using ConnectMail will seem like a familiar experience – buttons are similar to using a VCR or tape recorder. Consequently, there's no lengthy user's manual to wade through.
- ✧ You no longer have to express yourself through your computer keyboard alone. Now friends, family and business associates can see and hear you right from their computer screen by viewing streaming ConnectMail video.

ConnectMail has many advantages over other PC video products.

- ✧ ConnectMail works with many types of PC cameras including Logitech™, 3Com™, Intel™, IBM™, Kodak™, and Philips™ brand cameras. Click [HERE](#) to get \$10 off a Logitech™ Webcam Now!
- ✧ Recipients of your ConnectMail messages don't have to endure long downloads - videos are in streaming format and are viewed on the Web, not as an attachment to email. Because videos reside on ConnectMail servers, your recipients also don't have to worry about dreaded viruses.
- ✧ Storage and software running on ConnectMail servers also means that you and your recipients won't have to deal with personal computers getting clogged up with large multimedia or program files.

With ConnectMail, you now have the power to "say more, type less." Click [HERE](#) for a free trial of ConnectMail video messaging.

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